

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEREMY P. MILLER, VENKATAKRISHNAN UMAMAHESWARAN,
KURT A. WEISS and CHARLIE W. WOOD

Appeal No. 1996-3768
Application No. 08/292,887¹

ON BRIEF

Before GARRIS, OWENS, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed August 16, 1994. According to appellants, this application is a continuation of Application 08/018,992, filed February 18, 1993, now abandoned.

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 25, 27 through 30, and 32 through 35 which are all of the claims remaining in the application.

THE INVENTION

Appellants' invention is directed to a composite article having three layers. The composite article includes a substrate, a composite adhesive and a coating material. A composite adhesive bonds the coating material to the substrate material and comprises a rigid adhesive and a laminating adhesive wherein the rigid adhesive is no greater than 75% by weight of the composite adhesive. The expansion properties of the coating material are on the order of 300% different from that of the substrate material.

THE CLAIMS

Claims 1 is illustrative of appellants' invention and is reproduced below.

1. A composite Article of manufacture, comprising:

(A) a substrate material

(B) a coating material having expansion properties on the order of 300% different than said substrate material, and

(C) a composite adhesive comprising a suitable rigid adhesive and a suitable laminating adhesive which acts to bond said coating material to said substrate material wherein the rigid adhesive is no greater than 75% by weight of the composite adhesive.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references.

"APPLICATION, FABRICATION, AND INSTALLATION", Authorized Engineering Information, Section 4, January 30, 1991, pp. 41-48.

(LD3-1991)

"Fabricating With COLORCORE® Brand Surfacing Material", Formica Laminating Manual, 1991, pp. 1-10.

(Formica COLORCORE®)

2244 RESEARCH DISCLOSURE, "High Initial Tack Composite Adhesive", Vol. 1991, No. 328, August, 1991.

(2244)

THE REJECTIONS

Claims 1 through 25, 27 through 30, 32, 34 and 35 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

Claims 1 through 25, 27 through 30 and 32 through 35 stand rejected under 35 U.S.C. § 103 as being unpatentable over

Authorized Engineering Information hereinafter LD 3-1991 taken with either the Formica COLORCORE® reference or the 2244 Research Disclosure Abstract hereinafter 2244.²

OPINION

We have carefully considered the respective arguments for and against patentability by appellants and the examiner. We sustain the rejection of claims 1 through 25, 27 through 30, 32, 34 and 35 under 35 U.S.C. § 112, second paragraph and the rejection under 35 U.S.C. § 103 as to claims 25 and 33. We reverse the rejection under 35 U.S.C. § 103 as to claims 1 through 24, 27 through 30, 32, 34 and 35.

The Section 103 Rejection

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner relies upon a combination of three references to reject the claimed subject matter and establish a *prima facie* case of

² We refer in our statement of the rejection to the specific identification of the references used by the examiner in the Answer, pages 3-4.

obviousness. The premise of the rejection is that the primary reference to LD3-1991 discloses substrate, adhesive and decorative cover sheet. The composite adhesive as claimed by appellant is not specifically taught. However, the secondary references to Formica COLORCORE® and 2244 disclose the composite mixtures of laminating and rigid adhesives used in different locations. Accordingly, it would have been obvious to the person having ordinary skill in the art to modify LD3-1991 by utilization of mixtures of rigid adhesive and laminating adhesive as required by the claimed subject matter. See Answer, pages 4-5. See Formica COLORCORE®, page 6 and 2244, FIG.1.

The examiner however in his rejection, does not directly address the expansion properties required by the claimed subject matter.

Although, the subject matter of claim 1 requires, "a coating material having expansion properties on the order of 300% different than said substrate material," the limitation is first addressed by the examiner in the section of the Answer, labeled "Response to Argument." See Answer, page 6.

The expansion properties are discussed by the examiner only with respect to a single reference, i.e. Formica

COLORCORE®. The examiner acknowledges, "that the Formica reference does not literally disclose using two different materials having an expansion of at least 300%." See Answer, page 6. However, it is the examiner's position that appellants' specification includes the embodiments disclosed in Formica COLORCORE®. Hence, one would conclude that the substrate and the coating disclosed by Formica COLORCORE® necessarily meets the expansion properties "on the order of 300%" required by the claimed subject matter. In support of the examiner's rejection, reference is made to page 3, lines 24 - 34 and page 6, lines 13 - 23 of the specification. We disagree with the examiner's position.

We find that Formica® and the cellulose based substrate to which the Formica® is adhered have similar expansion rates. Our position is supported by the statement in the specification that, "the substrate and laminate are formed from similar materials and thus tend to contract and expand at similar rates and to similar degrees." See specification, page 3, lines 29 - 32. Our interpretation of that portion of the specification is that it serves to distinguish between appellants' claimed subject matter and the prior art represented by Formica®

materials. Our position is further supported by the disclosure in the specification at page 6, lines 13 - 23 which lists the more preferred substrates as including the cellulose based substrates; particle board, fiberboard and plywood, which are similar to Formica® in that they are all cellulose derived materials. Based upon the above considerations, we conclude that the reference to Formica COLORCORE® fails to disclose coating materials having expansion properties on the order of 300% different from the substrate material.

Furthermore, the primary reference LP3-1991 refers to, "problems which arise after fabrication and installation due to differentials in expansion and contraction between the laminate and substrate." See page 45. However, there is no requirement or recognition that the coating material and the substrate have the requisite expansion properties required by the claimed subject matter. Accordingly, we conclude that there is no reason why one of ordinary skill in the art would have been motivated to select either the coating or the substrate to obtain materials which have expansion properties differing on the order of 300%.

Based upon the above analysis, we have determined that the examiner's legal conclusion of obviousness is not supported by the facts. "Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

As to claims 25 and 33, on the record before us appellants have presented no arguments specific to either claim 25 or 33. The limitations of "expansion properties on the order of 300%" and a "rigid adhesive is no greater than 75% by weight of the composite adhesive," which are the basis for appellants' argument for patentability throughout the Brief, are not found in either claim 25 or 33. Accordingly, we affirm the examiner's rejection as to those claims.

The Rejection under 35 U.S.C. § 112.

Appellants have not argued in the record before us the propriety of the examiner's rejection under 35 U.S.C. § 112, paragraph two. Accordingly, we are constrained to summarily sustain it.

DECISION

The rejection of claims 1 through 25, 27 through 30, 32, 34 and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention is affirmed.

The rejection of claims 1 through 24, 27 through 30, 32, 34 and 35 under 35 U.S.C. § 103 as being unpatentable over Authorized Engineering Information (LD 3-1991) taken with either the Formica COLORCORE® reference or the 2244 Research Disclosure Abstract is reversed.

The rejection of claims 25 and 33 under 35 U.S.C. § 103 as being unpatentable over Authorized Engineering Information (LD 3-1991) taken with either the Formica COLORCORE® reference or the 2244 Research Disclosure Abstract is affirmed.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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